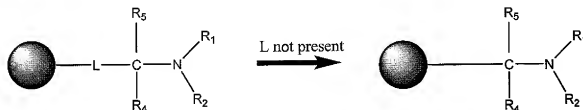


REMARKS

Applicants respectfully request reconsideration and allowance of all pending claims.

I. Status of the Claims

In this Amendment D, claims 15 and 20 have been amended for purposes of clarification, and to more particularly claim certain embodiments of the present application. Specifically, the structures therein have been amended to show a single bond extending from the solid phase support (sphere) to the carbon atom, C, and reference to L being a single bond has been removed. Applicants submit that claims 15 and 20, as amended, are clearly supported by the present application (as well as the identical International Application, as further discussed below). In particular, the present application clearly teaches that the linker "may or may not be present." (See, e.g., page 6, line 3, lines 21-23 and original claim 1 of the application). If L is not present in the conjugate of claims 15 and 20, the solid phase support (sphere) is attached to the carbon atom, C, by a bond as illustrated below.



Upon examination of the conjugate of claims 15 and 20, it is evident that when L is removed from the structure, the solid support would be attached to the carbon atom by a bond. Accordingly, claims 15 and 20 as amended are supported by the application.

It is additionally noted that the Office has agreed to rejoin withdrawn claims 35 and 36. Accordingly, claims 15-17, 20-24, 28 and 32-36 are pending and are currently under examination.

II. Certified Copy of the Priority Document

In the Office Action Summary (Form PTOL-326) attached to the present Office action, the Office made a notation stating that none of the certified copies of the priority documents have been received. The Office first made reference to the certified copy of the priority

document in the Office action dated July 23, 2008. In that Office action, the Office stated that Applicants were claiming foreign priority to EP 02078743.8 and that Applicants had not filed a certified copy of the European patent application as required by 35 U.S.C. §119. Applicants submit that the present application is a national stage of an international application under 35 U.S.C. §371 and that different rules apply to national stage applications, as compared to application that are not national stage applications, and that claim priority to a foreign application under 35 U.S.C. §119, regarding the filing of certified copies of foreign priority documents. In particular, Applicants are not required to furnish the Office with a certified copy of the foreign priority document; rather, the Office should request that the International Bureau furnish a copy of the certified priority document. (See, e.g., MPEP §1893.03(c)(II).)

As acknowledged by the Office in the July 23, 2008 Office action, Applicants had previously furnished to the International Bureau a certified copy of EP 02078743.8. The certified copy may be viewed at the international search database of WIPO, Patentscope, which is accessible at <http://www.wipo.int/pctdb/en/search-adv.jsp>. The Office is in possession of a non-certified copy of the European application as retrieved from the International Bureau.

According to MPEP §1828, when the International Bureau ("IB") properly receives a certified copy of the priority document, "[t]he IB will normally furnish copies of the certified copy to the various designated Offices so that the *applicant will not be required to submit certified copies* to each designated Office." (Emphasis Added.) Further, in MPEP §1893.03(c), which governs USPTO procedures relating to U.S. national stage applications, it is stated that "the International Bureau will forward a copy of the certified priority document to each Designated Office that has requested such document" and that "*the US Patent and Trademark Office, as a Designated Office, will normally request the International Bureau to furnish the copy of the certified priority document* upon receipt of applicant's submission under 35 U.S.C. §371 to enter the national stage." (Emphasis Added.) The copy of the certified priority document received from the IB "is acceptable to establish that applicant has filed a certified copy of the priority document."

The USPTO rules therefore establish that Applicants are not required to furnish a certified copy of the priority document, but rather the USPTO should request from the International Bureau a copy of the certified copy filed by Applicants with the International Bureau. In view of the USPTO rules, Applicants respectfully submit that the Office request a certified copy from the International Bureau, and further that the Office make of record in this application that the certified copy of the priority document was in fact received.

III. Priority Claim

Applicants note, on page 4 of the July 23, 2008 Office action and page 2 of the outstanding Office action, that the Office states Applicants claim the benefit of a prior-filed application under 35 U.S.C. §§119(e), 120, 121 or 365(c). For purposes of clarification, Applicants point out that the claim for benefit of the filing date of EP 02078743.8 is actually under 35 U.S.C. §119(a)-(d) (as authorized in U.S. national stage applications under 35 U.S.C. §365), and not under §§119(e), 120 or 121.

Additionally, Applicants note that the Office is of the opinion that "L" being a single bond is not specifically disclosed in the European application or in the PCT application and, as a result, Applicants are only entitled to a date of February 28, 2005, for purposes of prior art relating to the pending claims. Again, for purposes of clarification, Applicants believe the Office intended to use the date of entry into the national phase as the earliest filing date to which Applicants are entitled. The present application entered the national stage on February 18, 2005, and not February 28, 2005.

In response to the substance of the Office's position here, with respect to the priority date to which the present application is entitled, Applicants submit this issue is moot in view of the amendment of claims 15 and 20 noted above, inasmuch as these claims are clearly supported by the text of the present application, as well as the published International Application (WO 2004/022105) and the European Application (EP 02078743.8), upon which the present application is based. More specifically, Applicants point out that:

- (1) on February 18, 2005, Applicants entered the national stage in the United States by, among other things, filing a copy of the published International Application, which means the disclosures of the pending application and the International Application are identical; and,
- (2) the relevant text here, which provides for the linker L being optional (i.e., present or absent), is clearly present in the International Application, as well as the European application from which the International Application claims priority.

In view of the foregoing, Applicants submit the present application is entitled to a priority date that is at least as early as that of the International Application, which was filed on September 2, 2003.

IV. The Mundwiler et al. Reference is not Prior Art against the Pending Application

The Office has rejected pending claims 15-17, 20-24, 28 and 32-36 as anticipated under 35 U.S.C. §102(b) by the journal article "Preparation of No-Carrier-Added Technetium-99m Complexes via Metal-Assisted Cleavage from a Solid Phase," Bioconjugate Chem, vol. 15, pages 195-202, authored by Mundwiler et al. Applicants respectfully submit that the cited reference is not prior art under 35 U.S.C. §102(b) against the present application, inasmuch as (1) the present application is entitled to a filing date of at least September 2, 2003 (for the reasons previously detailed above), and (2) the cited reference did not publish until more than two months after that date (i.e., on December 16, 2003).

Applicants submit that, as a matter of law and as discussed above, the present application is entitled to the benefit of the filing date of the International Application (WO 2004/022105, or Application No. PCT/US2003/027665). Specifically, according to 35 U.S.C. 365(1), "a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States." The language of the statute itself means the Office does not have discretion to deny the present application benefit of the international filing date. The language of the statute is not permissive; it states clearly that Applicants "shall be" entitled to the right of priority of the international application. In view of the fact that the present application was properly filed as a national stage application of the noted International Application, which was filed September 2, 2003, and that this date precedes that of the December 16, 2003 internet publication date of the Mundwiler et al. reference, the Mundwiler et al. reference is simply not prior art against the present application.

Accordingly, Applicants respectfully request reconsideration of the present rejection of all pending claims.¹

¹ Given that the present rejection has been rendered moot for the reasons set forth in detail herein, Applicants see no reason to address the substance of the Mundwiler reference at this time. However, Applicants respectfully reserve the right to do so at a later date, if necessary.

CONCLUSION

In view of the foregoing, Applicants request favorable reconsideration and allowance of all pending claims.

The Commissioner is hereby authorized to charge Deposit Account No. 13-1160, should any fees be due at this time.

Respectfully submitted,



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Via EFS